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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,156	04/25/2000	Hidekazu Kikuchi	8663-0001-2X	9303

22850 7596 07/11/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

BERMAN, JACK I

ART UNIT	PAPER NUMBER
2881	

DATE MAILED: 07/11/2003

Please find below and or attached an Office communication concerning this application or proceeding.

09/557,156

KIKUCHI, HIDEKAZU

**Office Action Summary**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 12 March 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-11, 13-17 and 19-42 is/are pending in the application.

4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11, 13-17, 19-26, 28-32 and 34-39 is/are rejected.

7) Claim(s) 27, 33 and 40-42 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 25 April 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other \_\_\_\_\_

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13, 14, 19-24, 28-32, and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe in view of Auslander et al. for the reasons explained in the Final Rejection mailed on December 23, 2002.

Claims 12, 15, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe, Auslander et al., and Faure et al. for the reasons explained in the Final Rejection mailed on December 23, 2002.

Claims 27, 33, and 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable, for the reasons explained in the Final Rejection mailed on December 23, 2002, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed March 12, 2003 have been fully considered but they are not persuasive. Applicant argues that the recess 23 in the Hoppe apparatus does not comprise a hole through which an exposure beam can pass. Applicant's position is incorrect. Lines 15-17 in column 8 of Hoppe read: "In the center of the shaft 20 is a hole 18 in which an object carrier may be placed to hold the specimen 18a." While this statement refers specifically to the embodiment illustrated in Figure 12, the dashed line passing through rod 20 at the location of the recess 23 in Figure 1 is the conventional means used by draftsmen to indicate hidden lines and a person having ordinary skill in the art would understand these lines to indicate a hole passing through

rod 20. In fact, since the apparatus illustrated in Figure 1 is an electron microscope, which inherently requires the transmission of electrons through the specimen, it would not function if there were no hole located at the recess 23 because the rod 20 would block the transmitted electrons. (It is noted that the electron microscope illustrated must be a transmission electron microscope rather than a scanning electron microscope because the discussion at lines 5-11 in column 5 of the patent indicates that the detector is a fluorescent screen, a type of detector useful only in transmission type electron microscopes.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack I. Berman whose telephone number is (703) 308-4849. The examiner can normally be reached on M-F (8:30-6:00) with every second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on (703) 308-4116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Jack I. Berman*  
Jack I. Berman  
Primary Examiner  
Art Unit 2881

jb  
July 9, 2003